

REMARKS

The official action of 22 February 2010 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The courtesy of Examiner Patrick Niland in conducting a personal interview with Applicants' undersigned representative on 13 July 2010 is acknowledged with appreciation. The Interview Summary which issued at the interview accurately reflects what transpired, as amplified below.

Claim 1 has been amended in accordance with the description in the specification as filed at, for example, the last full paragraph on page 15 and the Examples, which show that complete neutralization of the carboxylic acid groups results in a resin that is less stable than if the neutralization is not complete (see Table 2 on page 57). The amendment to the claim is respectfully believed to remove the Examiner's concern, expressed at the interview, that claim 1 is not commensurate in scope with the evidence in the specification because it encompasses "soluble" polymers. The claim as amended excludes solubilized polymers and any other polymer whose stability is not enhanced as compared with a polymer whose carboxylic acid groups have been fully neutralized.

New claims 21-23 have been added more completely to define the subject matter which Applicants regard as their invention. The recitations in claim 21 draw support from the Examples in the specification which exemplify dispersion resins comprising a molar ratio of unneutralized repeat units to total (neutralized and unneutralized) repeat units of 5-67 % (see Table 2 on page 57). In claims 22-23, the recite resin has been limited in accordance with the description in the specification as filed at page 11, penultimate paragraph; the paragraph bridging pages 12-13 (see, in particular, page 13, lines 7-9) and original claim 10.

The claims as amended are believed to be free of the informalities noted at paragraph 7 of the official action and are otherwise believed to be sufficiently definite to satisfy

the dictates of 35 USC 112, second paragraph.

The claims stand rejected under 35 USC 102(b) as allegedly being anticipated by Yeates or under 35 USC 103(a) as allegedly being unpatentable over Yeates, either alone or in view of Yamazaki. Applicants respectfully traverse these rejections.

As discussed in the interview, the evidence of record shows that, for advantageous storage stability, it is necessary to control the molar ratio of the unneutralized groups in the claimed resin within the recited limits and to avoid neutralizing all of the groups (see Table 2 on page 57). In contrast, although Yeates may suggest the possibility of only partial neutralization, it clearly teaches that **complete** neutralization is desired.

Thus, in Yeates, the amount of ammonia used for neutralization in Example 1 exceeds the amount for completely neutralizing the resin. Moreover, Yamazaki discloses in paragraph [0020] that the amount of the alkali neutralizer may be not less than the value such that the resulting counter ion is able to neutralize the foregoing resin dispersant (neutralization equivalent). The amounts used in the Examples of Yamazaki are also not less than the neutralization equivalent. Neither of the cited references teaches or suggests the molar ratio of unneutralized groups (i.e., the first repeating unit structure) to neutralized and unneutralized groups as presently claimed (i.e. 1-67%) or the enhanced stability that can be achieved with this molar ratio.

Applicants respectfully submit that all claims of record are reasonably commensurate in scope with the Examples in the specification by virtue of the functional limitations in the claims which limit the ratio of the respective neutralized and unneutralized groups such that the claimed ink composition must be more stable than if all of the carboxylic acid groups were neutralized along with the teaching in the specification that it is the molar ratio of the groups (and not the specific kinds of the groups) that is important. See MPEP 2145 (“For example, a showing of unexpected results for a single member of a claimed subgenus, or a narrow portion of a claimed range would be sufficient to rebut a *prima facie* case of obviousness if a skilled artisan ‘could ascertain a trend in the exemplified data that would allow him to

reasonably extend the probative value thereof.”’). Claims 22-23 are *a fortiori* commensurate in scope with the Examples in that they recite the specific type of resin exemplified.

Claims 19 and the claims depending therefrom are additionally patentable in that they recite properties of the claimed composition that are not shown or suggested in the references.

For the above reasons, Applicants respectfully submit that the prior art rejections of record should be withdrawn.

Claims 19 and 20 were rejected under 35 USC 112, first paragraph, for allegedly violating the written description and enablement requirements. Applicants respectfully traverse these rejections.

Applicants respectfully submit that these claims draw clear support from the Examples in the specification. In the Examples, the inks of Examples 1 to 26 and Comparative Examples 1 and 2 comprise the dispersions described in the specification at pages 40-53 and other components described in Tables 1-1 and 1-2 on pages 53-54. Each of the inks was evaluated for storage stability in accordance with the Evaluation method described on page 56, which measures the fluctuation in viscosity difference between the inks when stored as described and claimed. Table 2 on page 27 provides the results of the storage stability evaluation. One of skill in the art would appreciate that the results are meant to show the storage stability, as measured by viscosity fluctuation width, that can be achieved through use of the claimed invention generally and not just through use of the claimed invention with the exemplified resins. See, e.g., page 40, penultimate paragraph (“The present invention will be illustrated with reference to the following Examples, but the invention should not be construed as being limited thereto.”).

In view of the above, Applicants respectfully submit that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed in claims 19-20. Accordingly, the claims are

respectfully believed to be in compliance with the written description requirement. See MPEP 2163.02. Moreover, Applicants respectfully submit that one of skill in the art could routinely (i.e., without undue experimentation) repeat the experimentation described in the specification so as to practice the invention as claimed with non-exemplified dispersion resins such that the claims are also in compliance with the enablement requirement. See MPEP 2164.01.

For the above reasons, Applicants respectfully submit that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Please charge Account No.12-0425 for any fees which may be due by this paper.

Respectfully submitted,

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